

REMARKS

In the final Office Action dated May 8, 2007,¹ the Examiner (1) rejected claims 1, 4, 7, 11, 12, 18, 20, 21, 23, 24, and 42-49 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,317,718 to Fano (Fano) in view of U.S. Patent No. 6,937,998 to Swartz et al. (Swartz); (2) rejected claims 10, 14, 15, 19, and 25 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and U.S. Patent Application Publication No. 2002/0194081 to Perkowski (Perkowski); (3) rejected claim 16 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and U.S. Patent Application Publication No. 2002/0138372 to Ludtke (Ludtke); and (4) rejected claims 17 and 26 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and U.S. Patent Publication No. 2003/0027555 to Malackowski et al. (Malackowski). Applicant respectfully traverses these rejections.

Claims 1, 4, 7, 10-12, 14-21, 23-26, and 42-49 are currently pending.

1. Rejection of claims 1, 4, 7, 11-12, 18, 20-21, 23-24, and 42-49 under 35 U.S.C. § 103(a)

Claims 1, 4, 7, 11, 12, 18, 20, 21, 23-24, and 42-49 stand rejected under 35 U.S.C. § 103(a) as obvious over Fano in view of Swartz. Applicant respectfully traverses these rejections.

As the Examiner is aware, a prima facie case of obviousness under §103(a) has three requirements. First, the reference or references, taken alone or combined, must teach or suggest

¹ The Office Action dated May 8, 2007, contains certain characterizations of the invention, the application claims, and the prior art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization made in the Office Action. In particular Applicant's remarks with respect to independent claims are sufficient to overcome the Examiner's rejections of all claims dependent thereon. Applicant's silence as to the Examiner's assertions with respect to dependent claims is

each and every element recited in the claims. See M.P.E.P. §2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure."

M.P.E.P. § 2143.

Claim 1 recites:

A method comprising:

determining whether a portable device is or is not located within a first site;

wherein when the portable device is located within the first site:

sending a menu of items located at the first site to the portable device for displaying to a user,

receiving, from the portable device, a selection by the user of at least one item from the menu of items located at the first site, and

sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user; and

wherein when the portable device is not located within the first site:

sending to the portable device a menu of sites located within a vicinity of the portable device for displaying to the user, and

receiving from the portable device a selection of a second site from the menu of sites by the user.

The combination of Fano and Swartz does not disclose or suggest this combination. For example, Fano does not disclose or suggest "determining whether a portable device is or is not

not a concession by Applicant to the Examiner's assertions as to those claims, and Applicant

located within a first site,” as recited in claim 1. With respect to this element, the Examiner cites to column 47, lines 20-24, which states:

A preferred embodiment of a system utilizes a Windows CE PDA equipped with a GPS receiver. The embodiment is configured for a mall containing a plurality of stores. The system utilizes a GPS receiver to determine the user's location. One advantage of the system is that it enables the retrieval of data for nearby stores without relying on the presence of any special equipment at the mall itself. Although the accuracy of smaller, inexpensive receivers is limited to approximately 75-100 feet, this has thus far proven to be all that is necessary to identify accurately the immediately surrounding stores.

Applicant submits that neither this section nor any other section of Fano discloses or suggests determining whether a portable device is or is not located within a first site, as recited in claim 1. This section of Fano cited by the Examiner only discloses identifying “nearby stores” and “immediately surrounding stores.” In fact, Fano discloses that, because of the limitations of the accuracy of receivers, it only determines “nearby stores” and “immediately surrounding stores.” This section of Fano does not disclose “determining whether a portable device is or is not located within a first site,” as recited in claim 1 (underline added here).

With respect to this first element of claim 1, the Examiner equates “a store closest to the user” as allegedly taught in Fano with “a first site” as claimed (e.g., “[a] store closest to the user containing items of interest constitutes a first site.”) (See Office Action at p. 3.) The Examiner also equates “when the device is within range of the store having items of interest” as allegedly taught in Fano with “when the portable device is located within the first site,” as claimed. (Id.)

reserves the right to analyze and dispute such assertions in the future.

Column 47, line 57, to column 48, line 26, cited to by the Examiner, discusses the “closest store:”

Browsing

To address the need of many shoppers to visit malls or shop generally without a particular destination in mind. FIG. 27 illustrates a display in accordance with a preferred embodiment of the invention. The display operates in a browse mode for use by shoppers as they stroll through the mall. In browse mode the system suggests items of interest for sale in the stores currently closest to the shopper. An item is considered to be of interest if it matches the categories entered in the goals screen. If there are no items of interest, the general type of merchandise sold at that store is displayed, rather than specific items. As the shopper strolls a map displays his or her precise current location in the mall. If an item displayed is selected by the shopper while browsing, the system alerts the shopper to the local retailer offering the same product for the lowest price, or announces the best local price. This search is restricted to the local mall, as that is the assumed radius the shopper is willing to travel.

Determining the “closest” store as in Fano, however, is different than determining when the device is located “within the first site,” as claimed. As discussed above, Fano only discloses identifying “nearby stores” and “immediately surrounding stores” because of technological limitations. Thus, Fano does not disclose or suggest at least “determining whether a portable device is or is not located within a first site,” as recited in claim 1.

In addition, Fano does not disclose or suggest “sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for

displaying to the user,” as claimed. The Examiner cites to Fano, column 47, lines 22-25, alleging Fano discloses this feature. (See Office Action at p. 4.) This portion of Fano recites:

If an item displayed is selected by the shopper while browsing, the system alerts the shopper to the local retailer offering the same product for the lowest price, or announces the best local price.

The Examiner equates “alert[ing] the shopper to the local retailer offering the same product for the lowest price,” as taught in Fano with “sending location information regarding the . . . item selected from the menu of items at the first site,” as claimed. (See Office Action at p. 4.) In particular, the Examiner equates the “local retailer” in Fano with “location information” as claimed. (Id.) This reading of claim 1 onto Fano is incorrect for at least two reasons.

First, as taught in Fano, “the item” selected by the shopper is not at the “local retailer.” Instead, Fano discloses that the “same product” as “the item” selected by the shopper is at the “local retailer.” In other words, Fano discloses alerting the shopper to a different store carrying a product that is the same as the item selected by the user. Second, alerting a shopper to a “local retailer” is not the same as alerting a shopper to “location information.” Fano does not disclose what information is provided to the user about the “local retailer” and the Office Action cannot assume that it includes “location information.” Therefore, Fano does not disclose or suggest “sending location information regarding the at least one item selected from the menu of items at the first site,” as claimed in claim 1.

Swartz does not cure the deficiencies of Fano described above with respect to claim 1. Swartz discloses a “portable terminal carried by a user and in wireless communication with a local area network for displaying data based on the physical location of the user.” See Abstract. Swartz also discloses a “base station[] located in a common area . . . for general information

gathering processes.” Col. 9, lines 38-41. Swartz does not disclose or suggest “determining whether a portable device is or is not located within a first site,” as recited in claim 1.

Since neither Fano nor Swartz, alone or in reasonable combination, discloses or suggests determining whether a portable device is or is not located within a first site, as required by claim 1, these references also cannot disclose or suggest: when the portable device is located within the first site (1) sending a menu of items located at the first site to the portable device for displaying to a user, (2) receiving, from the portable device, a selection by the user of at least one item from the menu of items located at the first site, or (3) sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user, as required by claim 1.

Thus, at least for the foregoing reasons, Applicant submits that claim 1 is not rendered obvious by Fano in view of Swartz. Claims 4, 7, 10, 11, and 42 depend on claim 1. Because Fano and Swartz do not render claim 1 obvious, these references also cannot render claims 4, 7, 10, 11, and 42 obvious. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 4, 7, 10, 11, and 42 under § 103(a).

Although independent claims 12, 20, 45, and 48 are of different scope than each other and claim 1, claims 12, 20, 45, and 48 include some similar features as claim 1. For example, claim 12 recites, among other things, “determine[ing] whether the portable device is or is not located within a first site.” Claim 20 recites, among other things, “determine[ing] whether a portable device is or is not located within a first site.” Claims 45 and 48 recite, among other things, “determining whether a portable device is or is not located within a first site.” Thus, at least for similar reasons as claim 1, Applicant submits that claims 12, 20, 45, and 48 are not rendered obvious by Fano and Swartz.

Claims 18, 21, 23, 24, 43, 44, 46, 47, and 49 depend on one of independent claims 12, 20, 45, or 48 and include all the features of their respective base claim. Because Fano and Swartz do not render claims 12, 20, 45, or 48 obvious, these references also cannot render claims 18, 21, 23, 24, 43, 44, 46, 47, or 49 obvious.

Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 4, 7, 11, 12, 18, 20, 21, 23-24, and 42-49 under § 103(a).

2. Rejection of Claims 10, 14, 15, 19, and 25 under 35 U.S.C. § 103(a)

Claims 10, 14, 15, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Perkowski. This rejection is respectfully traversed.

Claims 10, 14, 15, 19, and 25 depend on independent claims 1, 12, or 20 and include all the features of their respective base claim. As discussed above, Fano and Swartz do not disclose or suggest all the features of independent claims 1, 12, or 20. Perkowski does not cure the deficiencies of Fano and Swartz described above with respect to claim 1. Perkowski discloses an internet-based consumer service to carry out service-related functions along the demand side of a retail chain. See Abstract. Despite the lengthy pages of disclosure, Applicant submits that Perkowski does not disclose or suggest, for example, determining whether a portable device is or is not located within a first site, as required by claims 10, 14, 15, 19, and 25.

Because none of Fano, Swartz, or Perkowski, alone or in reasonable combination, disclose or suggest all the features of claims 10, 14, 15, or 25, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 10, 14, 15, 19, and 25 under § 103(a).

3. Rejection of Claim 16 under 35 U.S.C. § 103(a)

Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Ludtke. This rejection is respectfully traversed.

Claim 16 depends on claim 1. Ludtke does not cure the deficiencies of Fano and Swartz described above with respect to claim 1. Ludtke discloses a “system and method for locating items.” See Abstract. However, none of Fano, Swartz, or Ludtke, alone or in reasonable combination, disclose or suggest determining whether a portable device is or is not located within a first site, as required by claim 1.

Because none of Fano, Swartz, or Ludtke, alone or in reasonable combination, discloses or suggests all the features of claim 16, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 16 under § 103(a).

4. Rejection of claims 17 and 26 under 35 U.S.C. § 103(a)

The Examiner rejected claims 17 and 26 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Malackowski. This rejection is respectfully traversed.

Claims 17 and 26 depend on one of independent claims 12 or 20 and include all the features of their respective base claim. As discussed above, Fano and Swartz do not disclose or suggest all the features of claims 12 or 20. Malackowski does not cure the deficiencies of Fano or Swartz. None of Fano, Swartz, or Malackowski, alone or in reasonable combination, disclose or suggest determining whether a portable device is or is not located within a first site as required by claims 17 and 26.

Because none of Fano, Swartz, or Malackowski, alone or in reasonable combination, discloses or suggests all the features of claims 17 or 26, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 17 and 26 under § 103(a).

In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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